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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,823	07/23/2003	Scott Goldthwaite	WS-102	7792
27769	7590	12/28/2005	EXAMINER	
AKC PATENTS 215 GROVE ST. NEWTON, MA 02466			HANNON, CHRISTIAN A	
			ART UNIT	PAPER NUMBER
			2685	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,823

Applicant(s)

GOLDTHWAITE ET AL.

Examiner

Christian A. Hannon

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. During a telephone conversation with Alik Collins on 12/5/2005 a provisional election was made without traverse to prosecute the invention of Goldthwaite et al, claims 1-15. Affirmation of this election must be made by applicant in replying to this Office action. Claim 16-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 & 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Giraud et al (US 2005/0050437), herein Giraud.

Regarding claim 1, Giraud teaches a wireless mobile device adapted to access a wireless network comprising a subscriber identification module (SIM) card slot and a contactless smart card module electrically connected to said SIM card slot and wherein said contactless smart card module is adapted to receive and read information stored in

Art Unit: 2685

a contactless smart card and transmit said information to an entity via said wireless network (Page 3, [0040]; Giraud).

In regard to claim 9, Giraud teaches the wireless mobile device of claim 1, furthermore it is inherent that any wireless system must at least comprise an antenna, and therefore claim 1 must inherently further comprise an antenna for receiving and transmitting messages to and from said contactless smart card.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Landman et al (WO 01/86599), herein Landman.

Regarding claim 2, Giraud teaches the wireless mobile device of claim 1, however Giraud fails to further teach wherein said contactless smart card module is further adapted to receive information from said entity via said network and transmit and write said information in said contactless smart card. Landman teaches that said contactless smart card module is further adapted to receive information from said entity via said network and transmit and write said information in said contactless smart card (Page 7, Lines 1-6; Landman). It would have been obvious to combine the teachings of Giraud to include that said contactless smart card module is further adapted to receive

Art Unit: 2685

information from said entity via said network and transmit and write said information in said contactless smart card, such as that taught by Landman, in order to provide a removable storage for the wireless device.

6. Claims 3 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Landman and further in view of Althoff et al (US 2003/0018587), herein Althoff.

Regarding claim 3, Giraud teaches the mobile device of claim 1, however Giraud fails to teach wherein said information is selected from a group consisting of cardholder identification information, card identification information authentication information, smart card issuer information, financial institution information, digital goods, digital services and digital currency. Landman teaches wherein said information is selected from a group consisting of digital goods, digital services, and digital currency (Page 7, Lines 1-6; Landman). It would have been obvious to combine Giraud to include that said information is selected from a group consisting of digital goods, digital services, and digital currency, such as that taught by Landman, in order to broaden the data capable of being held on the smart card. It is noted that the phrase "token or other indicia of value" (Page 7, Line 2-3; Landman) is being interpreted to read on digital goods, services and currency, as these are all indicia's of value. However Giraud in view of Landman still fail to teach that said information is from the group consisting cardholder identification information, card identification information, authentication information, smart card issuer information and financial institution information. Althoff teaches that said information is from the group consisting cardholder identification

Art Unit: 2685

information, card identification information, authentication information, smart card issuer information and financial institution information (Page 5, [0053]; Althoff). It would have been obvious to combine the teachings of Giraud in view of Landman to include that said information is from the group consisting cardholder identification information, card identification information, authentication information, smart card issuer information and financial institution information, such as that taught by Althoff in order to further broaden the data capable of being held on the smart card.

In regards to claim 4, Giraud in view of Landman and further in view of Althoff teach the wireless mobile device of claim 3, furthermore Landman teaches wherein said digital goods are selected from a group consisting of electronic cash electronic coupons electronic gift certificates electronic transit tokens, music, software movies and books. All of these aforementioned items intrinsically have value and are therefore obviously indicia's of value as taught by Landman (Page 7, Lines 1-6).

7. Claims 5,6,11 &12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Yaqub et al (2004/0180657), herein Yaqub.

In regards to claim 5, Giraud teaches the wireless mobile device of claim 1, in addition Giraud also teaches a memory (Figure 1, MEMORY; Giraud), a CPU (Figure 3, CPU1; Giraud), a SIM card slot (Page 3, [0040]; Giraud) and a first application program associated with said memory and said CPU and being adapted to receive and transmit instructions from said contactless smart card module to said wireless mobile phone and the reverse (Figure 3, BR1; Giraud). However Giraud fails to teach a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile

device to said wireless network. Yaqub teaches a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile device to said wireless network (Page 1, [0002]; Yaqub). It would have been obvious to combine Giraud to include a SIM card connected to said SIM card slot said SIM card authenticating said wireless mobile device to said wireless network, such as that taught by Yaqub, in order to validate that the SIM card slot worked.

With respect to claim 6, Giraud in view of Yaqub teach the wireless mobile device of claim 5, furthermore Giraud teaches a second application program associated with said memory and said CPU and being adapted to route and transmit data and information among said wireless mobile phone, said smart card module, and other interfaces connected to said CPU (Page 3, [0041]; Figure 3, IN; Giraud).

Regarding claim 11, Giraud teaches the wireless device of claim 1, however Giraud does not explicitly teach the various types of wireless networks the wireless communication device could work on. Yaqub teaches that said wireless network is selected from a group consisting of a WWAN, WLAN, a private network, and a PAN (Page 2, [0025]; Yaqub). It would have been obvious to combine Giraud to include that said wireless network is selected from a group consisting of a WWAN, WLAN, a private network, and a PAN, such as that taught by Yaqub, in order to provide multiple access to multiple networks based on a corresponding SIM card.

In regards to claim 12, Giraud in view of Yaqub teaches the wireless mobile device of claim 11. Furthermore Yaqub teaches wherein said WWAN is selected from a group consisting of a GSM, CDMA, CDMA 2000 and WCDMA (Page 2, [0025]; Yaqub).

Art Unit: 2685

8. Claims 7 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Yaqub as applied to claims 5, 6, 11 & 12 above, and further in view of Althoff.

In regards to claim 7, Giraud in view of Yaqub teaches the wireless mobile device of claim 6, furthermore Giraud teaches a smart card interface (Page 3, [0040]; Giraud) and Yaqub teaches an infrared transceiver interface (Page 2, [0021]; Yaqub), however Giraud in view of Yaqub fail to teach wherein said other interfaces are selected from a group consisting of serial communication interfaces and infrared transceiver interfaces. However Yaqub teaches a magnetic stripe reader interface (Page 5, [0048]; Althoff), which obvious to one of ordinary skill in the art could be constructed using serial communication techniques. It would have been obvious to provide Giraud and Yaqub with a magnetic stripe reader interface, such as that taught by Yaqub, in order to provide a most convenient interface to an end user.

Regarding claim 8, Giraud and Yaqub teach the wireless mobile device of claim 6, furthermore with the addition of the Althoff reference teach that the group consisting of said CPU, said SIM card, an external SIM card, said contactless smart card, and an external card, all of which have been previously taught within the action, obviously all have a memory and therefore obvious of one of ordinary skill in the art have the capacity to store data, be it a first and second application, or any other data.

9. Claims 13 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Pathmasuntharan et al (US 6,955,299), herein Path.

Regarding claim 13, Giraud teaches the wireless mobile device of claim 1, however Giraud does not teach that the wireless mobile device is used for making financial transactions between a user and said entity with said contactless smart card over said network. However Path. teaches that the wireless mobile device is used for making financial transactions between a user and said entity with said contactless smart card over said network (Column 1, Lines 34-50; Path.). It would have been obvious to combine Giraud to include that the wireless mobile device is used for making financial transactions between a user and said entity with said contactless smart card over said network, such as that taught by Path., in order to add mobility to consumerism for the end user.

With respect to claim 14, Giraud and Path. teach the wireless mobile device of claim 13, furthermore Path. teaches that said financial transactions between said user and said entity are face-to-face (Column 1, Lines 34-50; Path.). The transactions described in Path. are all obviously everyday face-to-face transactions.

10. Claims 10 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud in view of Path. and further in view of Nemirofsky et al (5,880,769), herein Nemi.

In regards to claim 10, Giraud teaches the wireless mobile device of claim 1, also Giraud teaches wherein said wireless mobile device is selected from a group consisting of a mobile phone, a personal digital assistant, a wireless laptop computer & a personal computer (Page 1, [0016], [0017]; Giraud). However Giraud fails to teach where the wireless mobile device is selected from the group of a pager and a television remote. Path. teaches the use of the wireless mobile device as a pager (Column 6, Lines 50-53;

Art Unit: 2685

Path.). It would have been obvious to combine Giraud to include the pager taught by Path. in order to allow for end users to only have to carry a small pager, thereby unburdening the end user of unnecessary weight or heavier peripherals. However Giraud in light of Path. still does not teach the wireless mobile device consisting of a television remote control. Nemi. teaches the use of a television remote control as a wireless mobile device (Column 7, Lines 62-66; Nemi.). It would have been obvious to combine Giraud and Path. with the teachings of Nemi. in order to implement an ordinary household object to provide for the wireless mobile device. Furthermore combinations of the above are obvious and can readily be found in the state of the art.

Regarding claim 15, Giraud in view of Path. teach the wireless mobile device of claim 13, however Giraud and Path. fail to explicitly teach that said financial transactions between said user and said entity are remote. However, Nemi. teaches that said financial transactions between said user and said entity are remote (Column 2, Lines 5-10; Nemi.). It would have been obvious to combine the teachings of Giraud and Path. to include remote financial transactions such as that taught by Nemi. due to the nature of a wireless communication device, obviously suggests remoteness.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lagosanto et al (US 2005/0021600) disclose a method and device for establishing a network communication compatibility of terminal, for example to enable dialogue with a smart card application.

Hansen (US 2004/0243517) discloses a wireless point of sale transaction.

Kelly et al (US 6,097,292) disclose a contactless proximity automated data collection system and method.

Hofi (US 2003/0074317) discloses a device, method and system for authorizing transactions.

Halpern (US 2004/0077372) discloses a mobile phone communications system with increased functionality.

Chappuis (US 2003/0171993) discloses an electronic payment transaction via SMS.

Calhoon (US 2002/0188573) discloses a universal electronic tagging for credit/debit transactions.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian A. Hannon whose telephone number is (571) 272-7385. The examiner can normally be reached on Mon. - Fri. 8:00 AM - 4:30 PM.

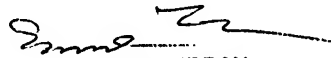
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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December 7, 2005



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